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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Harold Aaron Ludtke

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EXAMINER

KUCAB, JAMIE R

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/014,112	Applicant(s) LUDTKE ET AL.	
	Examiner JAMIE KUCAB	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,8-10,12,14,109-112 and 116-132 is/are pending in the application.
- 4a) Of the above claim(s) 8,9,110,116,117 and 128-132 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,10,12,14,109,111,112 and 118-127 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. Applicant's response filed October 30, 2008 is acknowledged.
2. Claims 1, 2, 8-10, 12, 14, 109-112, and 116-132 are pending in the application. Claims 8, 9, 110, 116, 117, 128-132 are withdrawn from consideration.
3. This Office action is given Paper No. 20090106 for reference purposes only.
4. Based on a comparison of the PGPub US 2002/0128980 A1 with Applicant's originally submitted specification, the PGPub appears to be a fair and accurate record of the Applicant's specification. Therefore, if necessary any references in this action to Applicant's specification refer to paragraph numbers in the PGPub.

Drawings

5. The drawings are objected to under 37 C.F.R. §1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "plurality of files associated with the unique identification trait of the person, the plurality of files being respectively associated with a plurality of providers" must be shown or the feature(s) canceled from the claims. No new matter should be entered.
6. Corrected drawing sheets in compliance with 37 C.F.R. §1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 C.F.R. §1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112 1st Paragraph

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1, 2, 10, 12, 14, 109, 111, 112, 118-127 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The elements "storing, in a database ... one of the plurality of providers" and "locating, from among the plurality of files in the database, a file associated with the

selected provider” were not previously disclosed, nor could antecedent basis be found in the specification.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 2, 10, 12, 14, 109, 111, 112, 118-127 are rejected under 35 U.S.C. §103(a) as being unpatentable over Krishnan et al., U.S. Patent No. 6,073,124 in view of Shinn, U.S. Patent No. 6,655,585 and further in view of Pare, Jr. et al. (US Pat. No. 6,269,348 hereafter “Pare”).

11. As per claims 1, 2, 10, 12, 14, 109, 111, 112, 118-127, Krishnan et al. teach a method and system for effecting a transaction between a person and a provider over a network comprising:

- establishing a communication link over said network between a communication device (customer computer system 311 in figure 3) and a selected one of said plurality of providers (virtual store 304 and content supplier server 306 and licensing and purchasing broker 307 in figure 3) (column 3 line 45-48, column 8 line 26-58);
- acquiring, at said communication device, at least one purchase selection provided by the person (column 6 line 66 - column 7 line 1 or step 2101 in Fig. 2);

- transmitting (via HTTP request message), from said communication device to said selected provider, the at least one purchase selection (column 6 line 66 - column 7 line 5);
- receiving, at said communication device from said selected provider, an order form (WEB page Fig. 7, step 401 in figure 4) for carrying out a transaction based on the at least one selection (column 15 line 37-40);
- in response to determining that the generated unique identification trait substantially matches the stored unique identification trait:
 - locating, from among the plurality of files in the database, a file associated with the selected provider, retrieving, from the database, a credit card number of the person and personal information of the person that are stored in association with the located file (figures 14-16, column 19 lines 35-67, column 21 lines 15-21),
 - automatically completing, at said communication device, the received order form using the retrieved credit card number and the retrieved personal information (figure 17, column 21 lines 15-21), and
 - automatically transmitting, to the provider from said communication device, the completed form and a verification code (e.g. data encrypted by user's key) (figures 12 and 17; column 21, lines 50-61) indicating that the generated unique identification trait and the stored unique identification trait substantially match (figure 15; column 10, lines 1-8; column 19, lines 35-67; column 21, lines 15-21).

12. However, Krishnan et al. do not explicitly recite generating, using a biometric device, a unique identification trait associated with the person and comparing, at said biometric device, the generated unique identification trait to the unique identification traits stored in a database.

13. Shinn teaches generating a unique identification trait (e.g. fingerprint) (column 3, lines 25-39) using a biometric device (e.g. PC, laptop, PDA, ATM, etc. - column 8, lines 25-35) (figure 5; column 8, lines 25-35) and in association with acquiring a credit card number and personal information (abstract; figure 5; column 8, lines 2-25), comparing at the biometric device the generated unique trait with a previously stored trait (abstract; figure 8, column 3, lines 25-35) and if the two traits match within a specified confidence level authorizing the transaction (abstract; column 8, lines 2-25; column 10, lines 1-13). Regarding a visual or audio indication to the user to provide a biometric sample, it is inherent that such an indication would exist otherwise the user would be able to make purchases without biometric verification a scenario that teaches away from the Shinn invention. Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Krishnan et al. and Shinn in order to prevent unauthorized users (such as users who have inappropriately obtained a credit card password belonging to another user- '124, figure 15, column 21, lines 2-9) from making purchases online purchases ('585, column 7, lines 24-29).

14. The combination of Krishnan/Shinn discloses all the elements of the claimed invention as detailed above, but Krishnan/Shinn fails to explicitly disclose storing, in a database, a unique identification trait of the person and a plurality of files associated

with the unique identification trait of the person, the plurality of files being respectively associated with a plurality of providers such that a given one of the plurality of files is associated with a particular one of the plurality of providers.

15. However, Pare teaches storing, in a database ("biometric database"), a unique identification trait of the person and a plurality of files associated with the unique identification trait of the person, the plurality of files being respectively associated with a plurality of providers such that a given one of the plurality of files is associated with a particular one of the plurality of providers (C5 L1-48, Fig. 5 and associated text).

16. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the method/system of Krishnan/Shinn to include the storing of Pare in order to achieve the predictable result of efficient lookup of data based on the user's biometric data and thereby enable efficient transaction processing.

17. The Official Notice that online order forms are old and well known is taken to be admitted prior art. The Official Notice was asserted by the previous Examiner in the Office action mailed October 5, 2006. Applicant did not traverse this Official Notice in Applicant's next response filed December 18, 2006. Therefore, it is taken to be admitted prior art. See MPEP 2144.03.

Examiner Note

18. The Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific

limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the Applicant, in preparing responses, to fully consider the reference in its entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim Interpretation

19. Independent claims are examined together, since they are not patentably distinct. If applicant expressly states on the record that two or more independent and distinct inventions are claimed in this application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

20. Functional recitation using the word “for,” “adapted to,” “operable to,” or other functional language (e.g. see claim 123 which recites “for carrying out a transaction based on the at least one purchase selection”) have been considered but are given little patentable weight¹ because they fail to add any structural limitations and are thereby regarded as intended use language. To be especially clear, the Examiner has considered the functional language. However, in a product claim, a recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not

germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2111.04 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

21. If Applicant desires to give the functional phrases greater patentable weight, the Examiner respectfully recommends (by way of example only) Applicant removes “for,” “adapted to,” “operable to,” or other functional language from the phrases where intended use is *not* desired. For example, a hypothetical claim with a positive recitation would be ‘a computer processing the instructions’ instead of a functional recitation such as ‘a computer *for* processing the instructions’ Like always, Applicants are reminded that any amendment must not constitute new matter.

22. The USPTO interprets claim limitations that contain statement(s) such as “*if, may, might, can, could, when, potentially, possibly*”, as optional language (this list of examples is not intended to be exhaustive). As matter of linguistic precision, **optional claim elements do not narrow claim limitations**, since they can always be omitted (*In re Johnston*, 77 USPQ2d 1788 (Fed. Circ. 2006)). They will be given less patentable weight, because language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. Applicant’s recitations following the various recitations of “in response to... unique identification trait” are **not** being interpreted by the Examiner as optional. The steps following “in response to...,” including “locating...,” “retrieving...,”

"completing..." and "transmitting..." are being interpreted as limiting steps in the method.

Response to Arguments

23. The Examiner expresses his appreciation for Applicant's citation on pg. 15 of the remarks filed June 6, 2008 of relevant portions of the specification where support for the amendments can be found. The Examiner's search for support for these amendments was not limited to these sections of the specification.

24. Applicant's arguments regarding the restriction requirement have been fully considered but they are not persuasive. First, Applicant argues that there is no examination burden due to subclass 73 being indented under subclass 64. The Examiner must respectfully disagree. There is at least burden with respect to non-prior art issues. See paragraph 3(d) of the requirement for restriction mailed October 15, 2008. Second, Applicant argues that the requirement for restriction is not timely. The Examiner must respectfully disagree. Applicant cites guidance from the MPEP regarding compact prosecution. The Examiner agrees with this guidance and the principle of compact prosecution in general, however, this guidance and the principle of compact prosecution do not allow the Examiner to ignore statute. Therefore, the restriction requirement is maintained and made final.

25. Applicant's arguments with respect to the 103 rejections of claims 1, 2, 10, 12, 14, 109, 111, 112, 118-127 have been considered but are moot in view of the new grounds of rejection.

Examiner Note

26. The Examiner has cited particular column, line, and/or paragraph numbers in the references as applied to the claims above for the convenience of the Applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the Applicant, in preparing responses, to fully consider a reference in its entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Conclusion

27. Applicant's amendment filed June 9, 2008 necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

28. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

29. References considered pertinent to Applicant's disclosure are listed on form PTO-892. All references listed on form PTO-892 are cited in their entirety.

30. Because this application is now final, Applicant is reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted).

Furthermore, suggestions or examples of claim language provided by the Examiner are just that--suggestions or examples--and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not* been addressed with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

31. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The Examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

32. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

33. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JK

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621